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04/17/2002

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EXAMINER

BERMAN, SUSAN W

ART UNIT PAPER NUMBER

1711

DATE MAILED: 04/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/754,243

Applicant(s)

VAN BENTHEM ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### *Specification*

The disclosure is objected to because of the following informalities: The definition of "WPU" on page 5, lines 23-29 and in claim 4 is not clear. It is not clear what amount of polymerizable unsaturation is present because the phrase "145 to 3000 grams per mole of unsaturated group" does not clearly define what is being measured in grams and what is being measured in moles. If applicant intends to set forth the weight in grams of polymer per mole of unsaturated group in the polymer, it should be so stated. If applicant intends to set forth the weight in grams of the unsaturated group per mole of polymer, it should be so stated. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a "composition" and then sets forth only one component of the "composition". A composition, by definition, contains at least two components, therefore, at least two different components should be set forth in the claim. If applicant intends to claim the compound set forth it should be so stated.

Claim 2 recites a "polymer P" but fails to define "P".

Claim 4 does not clearly set forth whether the polymer is a polymer containing (meth)acrylated alkylamide groups, as set forth in claim 2, or a polymer different from the polymer containing (meth)acrylated alkylamide groups. The definition of "WPU" is unclear, as discussed above.

In claim 5, it is not clear what the "crosslinker" is intended to crosslink.

Claim 6 fails to further limit claim 1.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Chevallier et al (5,360,836 or equivalent EP 0 263 749). Chevallier et al disclose a process for producing coatings by radiation crosslinking wherein a reactive diluent of formula (I) set forth in the Abstract is in the composition. A preferred compound (I) is the acrylate of isopropyl beta-hydroxyethylcarbamate or of beta-hydroxyethyloxazolidone. The disclosed diluent is added to a resin containing ethylencially unsaturated carbon-carbon double bonds, such as a urethane diacrylate. The acrylated reactive diluent disclosed by Chevallier et al would be expected to provide a powder coating paint binder composition since it corresponds to the required component set forth in the instant claims.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nason et al (4,656,202). Nason et al disclose coating composition comprising an acrylated cellulosic, an acrylated oligomer and a photoinitiator. The hydroxy groups in the cellulosic material are reacted with isocyanato acrylate to produce the acrylated cellulosic. See the formula in column 3, lines 1-11. The acrylated product anticipates a species of the compound of formula (I) in claim 2 wherein "A" is derived from a cellulose compound. Addition of a second polymer is taught in column 4. The examples teach solvent coating instead of powder coating. However, the recitation "radiation curable powder paint binder composition" in the preamble in the instant claims is not considered to be sufficient to distinguish over the prior art disclosure. The acrylated cellulosic disclosed by Nason et al would be expected to provide a powder

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coating paint binder composition since it corresponds to the required component set forth in the instant claims.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelley (3,366,613).

Kelley discloses monomeric compounds of the formula set forth in column 1, lines 15-39. Kelley teaches that the monomers can be polymerized to produce granular polymers (column 4, lines 35-38). With respect to claim 4, see the rejection under 35 USC 112 set forth above. With respect to claim 5, crosslinkers are taught in column 5, lines 58-61.

Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi (4,910,268). Kobayashi discloses acryl-functional macromonomers of formula (I) set forth in the Abstract and methods for preparation.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,245,829. Although the conflicting claims are

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not identical, they are not patentably distinct from each other because formula (I) in the instant claims encompasses species set forth in formula (I) in claim 1 of US '829. For example, "n" in the instant formula (I) can be 1 or 2 and Y can be hydrogen, a C<sub>1-8</sub> alkyl or a group of formula (II), thus reading on the formula set forth in US '829. "A" can be a monovalent or polyvalent organic group as set forth in claim 1 of US '829.

#### ***Information Disclosure Statement***

EP 0 53555 601 and JP 5 148 429 listed on PTO-1449 submitted 01-05-2001 have been lined out because no Abstracts or translations were submitted.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in PCT/NL99/00408 on 06-30-1999. It is noted, however, that applicant has not filed a certified copy of the PCT/NL99/00408 application as required by 35 U.S.C. 119(b).

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cowherd, III et al disclose carbamoyloxy acrylate compounds. Bank et al (4,912,239) disclose organopolysiloxanes having a reactive group selected from (meth)acryloxy, (meth)acrylamide, styryl or vinylbenzene radicals. Peeters et al (5,629,359) disclose radiation curable compositions comprising a compound of formula (I) set forth in the Abstract.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Berman whose telephone number is (703) 308-0040.

The fax number for this group is (703) 872-9310 or, for submissions after Final Rejection, (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist at telephone number (703) 308-0661.

S B  
4/11/02



Susan Berman  
Primary Examiner  
Art Unit 1711